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10/086,793	03/01/2002	Paul Turgeon	044624-15-CIP	1539
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BADII, BEHRANG	
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			3621	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/086,793  
Filing Date: March 01, 2002  
Appellant(s): TURGEON, PAUL

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Patrick M. Boucher  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/27/06 appealing from the Office action mailed 12/27/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct. The present application includes pending claims 1-15, 40-54, 61-69 and 77-90, all of which stand rejected.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Martin, Jr. et al., U.S. patent application publication 2004/0199467, Levine et al., U.S. patent RE38,255 and IBM, Research Disclosure RD414097.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION**

Claims 1-15, 40-54, 61-69 and 77-90 have been examined.

P = paragraph, e.g. p1 = paragraph 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 40-54, 61-69 and 77-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin, Jr. et al., U.S. patent application publication 2004/0199467, and further in view of Levine et al., U.S. patent RE38,255 and IBM, Research Disclosure RD414097.

As per claims 1, 40 and 77 Martin, Jr. et al., discloses a method/system of providing a payment service including the steps of:

processing a payment service request having independent identification information and ATM network compatible PINS, including the steps of (abstract, p4) validating said independent identification information (p4); and generating an ATM network transaction message containing at least a selected one of said pair of ATM network compatible PINS based at least in part on said validating step (p2&5); and

forwarding said ATM network transaction message to a financial institution over an ATM network for payment (p5).

Martin, Jr. et al. do not disclose a pair of ATM network compatible PINS. The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9). It would have been obvious to modify Martin, Jr. et al. to include a pair of ATM network compatible PINS such as that taught by IBM RD and Levine et al. in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 61 Martin, Jr. et al. discloses a method of a providing payment service comprising the steps of (abstract):  
providing independent identification information associated with said user's account at said financial institution (p4);  
validating said independent identification information (p4);  
generating a payment service request including an ATM PIN based upon said validating step (p2 & 5); and  
forwarding said payment service request to said user's financial institution over an ATM network for further processing (p5). Martin, Jr. et al. does not disclose providing an encoded data storage device to a user; said encoded data storage device including:  
data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution;

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data representing a second ATM network compatible PIN; wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution;  
first ATM PIN or said second ATM PIN.

Levine et al. and IBM RD disclose providing an encoded data storage device to a user (Levine et al.: col.7, 1-9); said encoded data storage device including:

data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution (Levine et al.: col.7, 1-9);

data representing a second ATM network compatible PIN (IBM RD); wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution (Levine et al.: col.6, 11-24; col.7, 1-9 and 39-55);  
first ATM PIN or said second ATM PIN (IBM RD).

It would have been obvious to modify Martin, Jr. et al. to include an encoded data storage device to a user; said encoded data storage device including:

data representing a first ATM network compatible PIN; wherein said first ATM PIN is a valid ATM PIN associated with said user's account at a financial institution;

data representing a second ATM network compatible PIN; wherein said second ATM PIN is an invalid ATM PIN not associated with said user's account at said financial institution; and

first ATM PIN or said second ATM PIN such as that taught by Levine et al. and IBM RD in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 2, 41 & 78 Martin, Jr. et al. discloses a payment service as described above. Martin et al. does not disclose providing a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon; wherein each one of said pair of ATM network compatible PINs being independently encrypted and different from one another. Levine et al. discloses providing a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon (col.7, 1-9). IBM RD does disclose a pair of ATM network compatible PINs being independently encrypted and different from one another. It would have been obvious to modify Martin, Jr. et al. to include a data storage device for interacting with a network access device; said data storage device having said pair of ATM network compatible PINS stored thereon; wherein each one of said pair of ATM network compatible PINs being independently encrypted and different from one another such as that taught by Levine et al. and IBM RD in order to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

As per claim 3 & 42 Martin, Jr. et al. further discloses generating said payment service request including PINs and independent identification information (abstract, p.4, 12, 57 and 79).

As per claim 4 & 43 Martin, Jr. et al. further discloses authorizing payment to a payee (abstract; p.4, 8-9, 12-13, 57 & 79).

As per claims 5, 6, 44, 45, 67, 80 & 81 Martin, Jr. et al. further discloses wherein said payment service request further includes an amount (abstract; p.4,12,57 & 79).

As per claim 7, 46, 66 & 82 Martin, Jr. et al. further discloses wherein said independent identification information comprises an electronic personal identification number (abstract; p.4,12,57 & 79).

As per claims 8, 9, 47, 48, 83 & 84 Martin, Jr. et al. further discloses wherein said validating step includes:

- providing an independent identification information offset (abstract; p.4,12,57 & 79);

- providing a transaction identifier representing an account number (p.11 & 33); wherein said transaction identifier does not represent said user's account number (abstract; p.4, 11-12, 33, 57 & 79);

- combining said user identification information and said offset to validate said user; and associating said user identification information and said offset with said transaction identifier to validate a user (abstract; p.4, 11-12, 33, 57 & 79).

As per claim 10, 49 & 85 Martin, Jr. et al. discloses a validating step as described above. Martin, Jr. et al. further discloses a message (p5, 61) transferred on an ATM compatible network, which required a pin (Abstract; p.4,5,12,57, & 79). Martin, Jr. et al. does not discloses wherein based at least in part on said validating step said ATM network transaction message includes a valid ATM network compatible PIN. Levine et



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al. discloses an ATM network transaction message including a valid ATM network compatible PIN (transmitting a pin; col.6, 11-24). It would have been obvious to modify Martin, Jr. et al. to include a message including a valid ATM network compatible PIN such as that taught by Levine et al. such that the pin can be transferred for security purposes as to checking the pin for accuracy and ownership to securely transmit the pin.

As per claim 11, 50 & 86 Martin, Jr. et al. further discloses said ATM network transaction message (p.5, 61). Martin Jr. et al. does not disclose an invalid ATM network compatible PIN. Levine discloses an invalid ATM network compatible PIN (col. 6, 11-24; col.7, 1-9 & 39-55). It would have been obvious to modify Martin et al. to include an invalid ATM network compatible PIN such as that taught by Levine et al. in order for the system to be able to distinguish an invalid pin from a valid pin and notify the user.

As per claim 12, 51 & 79 & 87 Martin, Jr. et al. further disclose wherein said payment service request further includes a payee (p8, 9 & 13).

As per claim 13, 14, 52, 53, 88 & 89 Martin, Jr. et al. further disclose including inputting said independent identification information at a network access device (abstract).

As per claim 15, 54 & 90 Martin, Jr. et al. further disclose wherein said electronic personal identification number (account number) comprises a number other than a user's ATM network compatible PIN (p33 & 11).

As per claim 62, Martin, Jr. et al. further disclose a primary account number associated with said user's bank account (p11, 33).

As per claim 63, Martin, Jr. et al. further disclose a bank identification number (routing number, p11, tables 1&2).

As per claim 64, Martin, Jr. et al. further disclose wherein said generated payment service request is stored by a merchant for forwarding to a financial institution at a selected time (abstract).

As per claim 65, Martin, Jr. et al. further disclose wherein said forwarded payment service request is forwarded to said financial institution a plurality of times (abstract).

As per claim 68, Martin, Jr. et al. further disclose wherein the step of forwarding said payment service request to said user's financial institution over an ATM network for further processing further includes authorizing payment to a payee (abstract; p.8,9,13).

As per claim 69, Martin, Jr. et al. further discloses wherein a merchant provides said independent identification information and data received by a user to a processor for validating said independent identification information and generating said payment service request (abstract; p4). Martin, Jr. et al. does not disclose a first ATM network compatible PIN and a second ATM network compatible PIN. IBM RD discloses a first ATM network compatible PIN and a second ATM network compatible PIN. It would have been obvious to modify Martin, Jr. et al. to include a first ATM network compatible PIN and a second ATM network compatible PIN such as that taught by IBM RD in order

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to have a first and a second pin to a user of an ATM card, each pin providing access to different parts of the transaction.

#### **(10) Response to Argument**

The correction of the application number is noted.

The applicants arguments pertaining to claims 1, 40 and 77 of the use of a pair of pins is fully disclosed by the IBM reference and/or Levine. The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9).

Applicant on page 8 of the brief is arguing features not claimed. The "simultaneous inclusion of both these PINs as part of a payment service request" is not included in claim.

Again on page 8, applicant states that none of the references "teach or suggest that a pair of PINs be part of a payment service request". Here again, the IBM reference teaches a pair of use of a pair of pins. Further Martin and Levine disclose payment procedures that require the use of pins (abstract and as described above). Also, the IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9).

Further the word "request" is interpreted broadly. Request could mean a request from a user to a server or from a computer to another computer.

Applicant, on page 9 of the brief, states that "IBM neither teaches nor suggest a service request that has a pair of PINs". As stated above, IBM discloses a pair of pins and Martin and Levine disclose a service (payment) request, which includes the use of PINs. The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9).

Applicant on page 10 of the brief is arguing features not claimed. Claim 1 does not include the simultaneous use of a pair of pins. The claim states "at least a selected *one* of said pair of ATM network compatible PINS". The claim language does not exclude the use of a single pin. Further, the IBM reference clearly shows the use two pins. The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9).

For claim 61, Levine discloses a data storage device throughout the reference (abstract; col.7, 1-9, as described above). IBM discloses two pins and these two pins or any other data could be stored in the database disclosed in Levine (as described above). The IBM research disclosure and Levine et al. disclose a pair of ATM network compatible PINS (IBM RD; Levine et al.: col.7, 1-9).

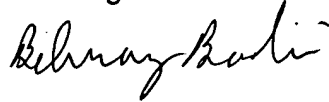
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Behrang Badii



Conferees:

James Trammell



Hyung Sough

